



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,856	11/24/2003	Timothy Roberts	920476-95165	5181
23644 7590 10/07/2008 BARNES & THORNBURG LLP P.O. BOX 2786 CHICAGO, IL 60690-2786				
EXAMINER AKINTOLA, OLABODE				
ART UNIT 3691		PAPER NUMBER		
NOTIFICATION DATE 10/07/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent-ch@btlaw.com

Office Action Summary

Application No.

10/720,856

Applicant(s)

ROBERTS, TIMOTHY

Examiner

OLABODE AKINTOLA

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

Claims 1 to 20 are pending, of which claims 1,8,11 and 17 are in independent form.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-9, 11-13 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nauer et al. (US 2002/0161601 A1), hereinafter Nauer.

Re claim 1, Nauer (US 2002/0161601 A1) discloses in Fig. 3 a billing method wherein the method comprises;

providing a set of rules **[the billing data included in the billing data record type relate to the billing parameters, their value, dimension, see paragraph 54, lines 5-7]** and determining from said rules and each packet address, a respective billing tariff and a network user account to be debited for the transport of that packet **[and the agreed tariffs 17 for the billing parameters, see paragraph 54, lines 7-9]**; and the method further comprises obtaining a coupon from an account database, representing an amount of credit, and debiting a network user account by the amount of that credit, and allowing the transport of packet traffic for that network user **[prepaid cards can be debited immediately, and there is no need for subsequent issuing of bills]**.

Nauer does not explicitly teach that the debiting of the network user is done before allowing the transport of the packet traffic for the network user. Official notice is hereby taken that the concept of debiting a user account before providing a good or service (in this case transporting packet traffic for the network user) is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nauer to include this feature for the obvious reason of guaranteeing that service provider receives payment before providing such goods or services.

Re claim 2, Nauer (US 2002/0161601 A1) discloses a method wherein
account details for network users and account details of providers of goods and services
[the creation of billing data record type and the collection of associated use data, creation

of party-specific billing data records] are stored in a common accounts database [can be combined into one database transaction in each instance, and can be performed distributed within the network, see paragraph 58, lines 6-11 and Fig. 5]

Re claim 3, Nauer (US 2002/0161601 A1) discloses a method wherein;
transfers of credit between accounts stored in the accounts database are determined from coupons generated for each transaction **[from the billing data record which contains the billing parameter based on cost acceptance by operators and user, it is possible to make an accurate list of all the cost and credits for the subscriber and of all the costs and credits for the operators thereof, see paragraph 20, lines 1-6].**

Re claims 4 and 12, Nauer (US 2002/0161601 A1) discloses a method wherein
network users have prepaid and postpaid accounts **[creation of a billing model for each subscriber may be used for any type of billing, such as Prepaid, or Postpaid via a bank or credit, see paragraph 29, lines 1,6-8].**

Re claims 5 and 13, Nauer (US 2002/0161601 A1) discloses a method wherein
each user account is accorded a respective credit limit **[each data record is used as an input for the party-specific billing processes where the use data used in the billing such as immediate billing, or for the last 30 days have been stipulated, see paragraph 88, lines 1-5]**

Re claim 6, Nauer (US 2002/0161601 A1) discloses a method wherein

user validation is performed prior to completion of a transaction **[each subsidiary data record type is valid until the connections are ended or a rule prescribed for the billing parameters applies as an option. The criteria crucial for end of the validity of a subsidiary data record type also can be administered; see paragraph 38, lines 7-10, 15-16]**

Re claim 7, Nauer (US 2002/0161601 A1) discloses in the background of the invention, a method wherein

The network is a wireless network **[a multimedia network results from connecting mobile radio networks and the Internet to make use of internet services, applications and contents in the mobile radio network, see paragraph 3, lines 1-4]**

Re claim 8, Nauer (US 2002/0161601 A1) discloses a method wherein

On-line shopping in which the cost of goods and services purchased by a customer are debited to that customer's prepaid or postpaid account with a network operator **[creation of a billing model for each subscriber may be used for any type of billing, such as Prepaid, or Postpaid via a bank or credit, see paragraph 29, lines 1,6-8]**, and a corresponding credit is applied to an account held by a provider of those goods or services **[a payment flow going to a subscriber or operator can be equated, to a credit to his/her account and a payment flow leaving the subscriber or the operator is comparable to a debit to his/her account, see paragraph 17, lines 4-7]** and the method further comprises obtaining a coupon from an account database, representing an amount of credit, and debiting a network user account by the amount of

that credit, and allowing the transport of packet traffic for that network user **[prepaid cards can be debited immediately, and there is no need for subsequent issuing of bills]**

Nauer does not explicitly teach that the debiting of the network user is done before allowing the transport of the packet traffic for the network user. Official notice is hereby taken that the concept of debiting a user account before providing a good or service (in this case transporting packet traffic for the network user) is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nauer to include this feature for the obvious reason of guaranteeing that service provider receives payment before providing such goods or services.

Re claim 9, Nauer (US 2002/0161601 A1) discloses in the background of the invention a method wherein

a transaction charge is retained by the network operator **[a billing method for the use of multimedia network which permits rapid settlement of accounts between, any number of operators/subscribers and allows the statement items to be associated with a selected transaction step, see paragraph 11, lines 1-6 and Fig. 4; 24b]**

Re claims 10 and 14, Nauer (US 2002/0161601 A1) discloses a method meeting all preceding limitations including a method, wherein;

A supplier of goods and services is credited with a portion of the network operator's revenue for the transport of the packet traffic relating to a transaction **[a transaction step may**

include the use of service with content and at the same time for not only the user but also an operator of the portal, an operator for the content, an operator for the access network and an operator for the transport network to be involved in between whom accounts need to be settled; see paragraph 10, lines 5-8].

Re claim 11, Nauer (US 2002/0161601 A1) discloses a method wherein

Providing combined billing of a communications packet network user for the delivery of communications services to that user **[a subscriber in the multimedia network can use both the mobile radio service and an Internet access service from a served operator (convergent billing), see paragraph 21, lines 3-5]** and for the on-line purchase of goods and services by the user via the communications network, **[communication services and for on-line purchases of goods and services via communication network, see paragraph 71, lines 4-5]** wherein the method comprises; providing a set of rules , **[the billing data included in the billing data record type relate to the billing parameters, their value, dimension, see paragraph 54, lines 5-7]** and determining from said rules and each packet address, a respective billing tariff and a network user account to be debit for the transport of that packet **[and the agreed tariffs 17 for the billing parameters, see paragraph 54, lines 7-9]** and the method further comprises obtaining a coupon from an account database, representing an amount of credit, and debiting a network user account by the amount of that credit, and allowing the transport of packet traffic for that network user **[prepaid cards can be debited immediately, and there is no need for subsequent issuing of bills].**

Nauer does not explicitly teach that the debiting of the network user is done before allowing the transport of the packet traffic for the network user. Official notice is hereby taken that the concept of debiting a user account before providing a good or service (in this case transporting packet traffic for the network user) is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nauer to include this feature for the obvious reason of guaranteeing that service provider receives payment before providing such goods or services.

Re claim 15, wherein “said network comprises a wireless network” is substantially similar to claim 7, thus the basis of the rejection is based on rational stated in claim 7

Re claim 17, an apparatus for processing the method disclosed in claim 1. Therefore the rejection from claim 1 also applies to claim 17.

Re claim 18, an apparatus for processing the method as disclosed in claims 4 and 5. Therefore the rejection from claims 4 and 5 applies to claim 18.

Re claim 19, an apparatus for processing the method disclosed in claim 5. Therefore the rejection from claim 5 also applies to claim 19.

Re claim 20, an apparatus for processing the method as disclosed in claims 7 and 15.
Therefore the rejection from claims 7 and 15 applies to claim 20.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nauer (US 2002/0161601 A1) in view of the examiner's prior knowledge of the art.

Re claim 16, Nauer (US 2002/0161601 A1) discloses a method meeting all preceding limitations of the parent claim, however Nauer (US 2002/0161601 A1) fails to explicitly disclose of a method wherein;

“software in machine readable form on a storage medium and arranged to perform the method” as stated in the parent claim.

A multimedia wireless network mainly uses Third generation (3G) mobile radio networks, which already includes efficient use of Internet services as well as Internet applications and contents. For a person skilled in the art, implementing software development for integrated multimedia networks is considerably cost effective, and efficient in terms of operation as supposed to hardware implementations. Thus, it would have been obvious to one of ordinary skill in the art at the time to be motivated to incorporate software in a computer readable form in the method of Nauer (US 2002/0161601 A1) to enhance decrease implementation cost and to enhance speed and efficiency.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tubinis (US 2002/0014367 A1) discloses a method and system for processing a subscriber's account for a multimedia service via communications networks. The information regarding the Billing Collector and Multiplexer device and billing system device are relevant materials.

Battle et al. (US 2003/0041022 A1) discloses a method that utilizes an electronic money instrument for transactions online. The information regarding e-money for conducting transactions such as transfers and payment are of relevance.

Ruckart et al. (US 2003/0086545 A1) discloses a method and system for paying for multimedia communications with prepaid credit. The information regarding system for storing data, controlling application software and the prepaid module are of relevance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691